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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,620	01/30/2006	Matthias Winkel	ZAHFRI815US	7373
20210 7590 11/17/2008 DAVIS BUJOLD & Daniels, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301				
EXAMINER				
LE, DAVID D				
ART UNIT		PAPER NUMBER		
3655				
MAIL DATE		DELIVERY MODE		
11/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/566,620

**Applicant(s)**

WINKEL ET AL.

**Examiner**

David D. Le

**Art Unit**

3655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is the second Office action on the merits of Application No. 10/566,620, filed on 30 January 2006. Claims 23-35 are pending.

### **Documents**

2. The following documents have been received and filed as part of the patent application:
  - Copy of Foreign Priority Document, received on 01/30/06
  - Information Disclosure Statement, received on 01/30/06

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 23-35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed invention as described in the present specification, does not reasonably provide enablement for the claimed inventions as recited in claims 23-33. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

#### **Claims 23-33:**

Claim 23 recites the limitations:

- “Determining attainment of a predetermined threshold speed and carrying out a second downshifting operation; and

- Terminating downshifts in the second downshifting operation with the clutch located between the vehicle drive motor and the transmission maintained in a disengaged state."

The mentioned limitations contradict paragraphs [017] to [019] of the present specification for the following reasons:

First, according to paragraph [018], the second downshifting operation is not carrying out until the speed is below the threshold speed, not at the attainment of the threshold speed, as claimed.

Second, according to paragraph [019], the downshifts in the second downshifting operation are not terminating until the clutch is closed/engaged state.

Accordingly, as set forth above, the present specification does not support the above claimed limitations.

Claims 34-35:

Claim 34 recites the limitations:

- "Carrying out a first downshifting operation in a coasting mode of the automatic transmission from a higher gear to a lower gear by opening a clutch between the automatic transmission and a vehicle engine, shifting from the higher gear to the lower gear in the automatic transmission, and terminating the first downshifting operation by closing the clutch between the automatic transmission and the vehicle engine so that engine compression influences the vehicle;

- Determining attainment of a threshold speed;
- Carrying out a second downshifting operation of the automatic transmission through a succession of downshifts by opening the clutch between the automatic transmission and the vehicle engine, shifting from the higher gear to the lower gear in the automatic transmission, and maintaining the clutch between the automatic transmission and the vehicle engine in an open state during each successive shift in the second downshifting operation, determining a driver desire for positive drive torque; and
- Terminating the second downshifting operation by closing the clutch between the vehicle engine and the transmission carrying out the second downshifting operation."

The mentioned limitations contradict paragraphs [017] to [019] of the present specification for the following reasons:

First, according to paragraph [018], the second downshifting operation is not carrying out until the speed is below the threshold speed, not at the attainment of the threshold speed, as claimed.

Second, according to paragraph [018], the second downshifting operation carries out additional/successive downshifts, not the same "the higher gear to the lower gear" of the first downshifting operation, as claim.

Accordingly, as set forth above, the present specification does not support the claimed limitations.

***Response to Arguments***

5. Applicant's arguments with respect to claims 23-35 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0900-1730).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David D. Le/  
Primary Examiner, Art Unit 3655  
11/12/2008

ddl